

REMARKS

Claims 50-69 remain in this application, with claims 50 and 61 amended for further clarification. The amendment to claim 50 is supported by the specification at, for example, page 19, line 10 through page 20, line 17. Specifically, claim 50 has been amended to clarify the testing step by replacing it with the following language:

processing a defined topic comprising one or more human-language words to determine whether it is qualified;

determining, at a host server, if the defined topic is duplicative of pre-existing topics stored within a memory of a server computer;

With respect to the processing step, the specification describes, at page 19:10-22, that the defined topic is processed to determine the language the topic is submitted in, whether there are any misspellings, identification of non-dictionary words, and other topic problems. Specification, at pages 19:10-13. The specification further discloses:

For example, the host may screen for words deemed too offensive to appear as topics, or words that are otherwise likely to be used for Webrooms that the Webroom host does not desire to host. However, it is anticipated that in general, topic processing is preferably limited to identifying common spelling defects, semantic inconsistencies, and duplicate topics in order to avoid placing unnecessary restrictions on topic creation and to facilitate the founding process.

Id. at page 19:13-18. The specification further discloses that “If a problem with the topic is identified during processing, the topic is deemed not qualified at decision step 412...” *Id.* at page 19:23-24. With respect to the determining step, the specification describes, at page 20:4-17, for example, how a topic is tested to determine if a Webroom with the same topic already exists. Claim 61 was amended to make the claim language consistent with amended claim 50.

Applicant respectfully submits that no new matter has been added by these amendments.

Rejection of Claims 50-69 under 3 U.S.C. § 103 is Traversed

Claims 50-52, 55, 57, 59-61, 66, 68 and 69 stand rejected under 35 U.S.C. § 103(a) over McNaughton (App. No. 2006/0242583) in view of Dyko et al. (U.S. 6,240,412) and further in view of Kurzrok (U.S. 6,260,064); claims 53, 54, 56, 58, 62, 64-65 and 67 stand rejected under 35 U.S.C. § 103(a) over McNaughton, Dyko, Kurzrok, and Ginn (U.S. 6,275,811); and claim 63 stands rejected under 35 U.S.C. § 103(a) over McNaughton, Kurzrok, Ginn, and Dan (App. No. 2006/0149833). All of the foregoing rejections are respectfully traversed, as explained in more detail below.

A. The Combination of McNaughton, Dyko and Kurzrok Fail to Establish a Prima Facie Case of Obviousness for Claims 50-69

Applicant articulated the differences between McNaughton and independent claim 50 in Applicant's previous response, filed October 24, 2008. Applicant incorporates those arguments herein and respectfully submit that the rejection to claims 50-69 be reconsidered and withdrawn in view of the clarifying claim amendments.

In Applicant's previous response, filed October 24, 2008, Applicant amended independent claim 50 to further recite the step of:

testing the defined topic to ensure that it is unique from any additional topics already defined within a memory of the server computer and that all of the human-language words making up the defined topic have a recognized meaning;

The Office Action implicitly conceded that the references previously cited failed to disclose this claim element by citing a new reference, Dyko, as disclosing this claim element. For the reasons articulated below, however, Dyko similarly fails to disclose, teach or suggest this claim element and a prima facie case of obviousness is not supported by the combination of the cited references.

Notwithstanding the failure of Dyko to disclose the testing step, Applicant has amended claim 50 to more clearly recite this step and not for purposes of distinguishing the prior art. Specifically, claim 50 now recites:

processing a defined topic comprising one or more human-language words to determine whether it is qualified;

determining, at a host server, if the defined topic is duplicative of pre-existing topics stored within a memory of a server computer;

Applicant respectfully submits that Dyko fails to disclose, teach or suggest either of the processing or determining steps.

The Office Action failed to point to any teachings in Dyko as to “testing the defined topic to ensure...that all of the human-language words making up the defined topic have a recognized meaning.” Indeed, Dyko does not appear to disclose, teach or suggest this claim element in the context of Applicant’s claims. Applicant has amended claim 50 to more positively recite this step as “processing a defined topic comprising one or more human-language words to determine whether it is qualified.” Because there is no corresponding disclosure in Dyko as to the processing step, Applicant respectfully submits that claim 50 is allowable over the cited references.

Dyko discloses a method in which authors provide the data needed to enable user navigation between the work of different authors without the need for predefined links, enable searches for information based on user context and identify reuse candidates before information is written and therefore minimize duplication. Dyko, Abstract. Significantly, Dyko discloses that the authors, themselves, determine whether or not duplicate topics exist:

The authors determine if an article intersection actually does represent duplicated information...Whatever the resolution, ***the author*** provides appropriate input to the program specifying whether to reuse a previously created article.

Dyko, at 8:66-9:6 (emphasis added). This is in contrast to the determining step in claim 50, which has now been amended to more positively recite that the step is being performed by the host server.

Failing to disclose all of the elements of independent claim 50, McNaughton,

Dyko and Kurzrok cannot bar its patentability under 35 U.S.C. § 103(a). The remaining claims 51-69 are also allowable, at least as depending from allowable claim 50.

No Motivation To Combine

The deficiencies of McNaughton, Dyko and Kurzrok render identifying a motivation for their proposed combination irrelevant. Even when combined, these references do not disclose all of what is claimed. Nonetheless, it is respectfully submitted that the Office Action wholly fails to establish a motivation for alleged combination. In fact, the Office Action does not even identify any motivation to combine Dyko with either of McNaughton or Kurzrok:

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of McNaughton, Dyko and Kurzrok because the teaching of Kurzrok would enable to provide an automatic rating system for some of its content and to generate a rating indicium which is sent to the content provided and/or generate a payment method [Kurzrok, col. 1, lines 6-11].

Office Action, at pages 6-7. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulate reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Indeed, the combination of McNaughton and Dyko are entirely incompatible. The Office Action asserts that McNaughton discloses Applicant’s “defined topic” via “an online community service [Abstract] including a message area as a place for posting and responding to messages relating to a specific topic [Figure 6; and paragraphs 0005 and 0006] and interaction with other members of the community , such as chatting [paragraphs 0011, 0014, 0015, 0017 and 0034].” Office action, at page 2, ¶ 4. Still, it is unclear where, if at all, McNaughton teaches Applicant’s claimed “defined topics” as

argued in Applicant's previous response.

Lacking this clarification as to what the Office Action asserts to be the "defined topics", there can be no motivation to combine McNaughton and Dyko. If the Office Action contends that McNaughton's disclosure of chat messaging or threaded messages, there would be no motivation to incorporate "testing the defined topic to ensure that it is unique from any additional topics already defined within a memory of the server computer and that all of the human-language words making up the defined topic have a recognized meaning", allegedly disclosed by Dyko. Such a combination would make chat messaging or threaded messaging inoperable. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Lacking a proper rationale for the combination, in addition to the other deficiencies of McNaughton, Dyko and Kurzrok as noted above, a *prima facie* case of obviousness has not properly been made out, and the rejections should be withdrawn.

The arguments presented herein are sufficient to fully traverse the rejections set forth in the Office Action. Therefore, Applicants have not presented all possible arguments, and may not have refuted the characterizations of either the claims or the prior art as may be found in the record. However, the lack of such arguments or refutations is not intended to waive such arguments or indicate concurrence with such characterizations.

CONCLUSION

In view of the foregoing, the Applicant respectfully submits that Claims 50-69 are in condition for allowance. Reconsideration and withdrawal of the rejections is

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respectfully requested, and a timely Notice of Allowability is solicited. If it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

Respectfully submitted,

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